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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,772	04/04/2001	George J. Chanos	CHANOS.001A	3658

20995 7590 12/16/2009  
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EXAMINER
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MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3688

NOTIFICATION DATE	DELIVERY MODE
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12/16/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 09/825,772	<b>Applicant(s)</b> CHANOS, GEORGE J.	
	<b>Examiner</b> JAMES W. MYHRE	<b>Art Unit</b> 3688	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 30-45 and 55-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-45 and 55-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Amendment*

1. This Office Action is in response to the amendment filed on October 21, 2009. The Amendment did not add, delete, nor amend any claims. Thus, the currently pending claims remain Claims 30-45 and 55-60.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 30-45 and 55-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reisman (5,694,546) in view of Solomon et al (6,847,935).

**Examiner's Note.** Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "consumer information" throughout the

Art Unit: 3688

claims is used by the claims to mean “information about consumer products” (Claim 30, lines 1-2) while the accepted meaning is “information about consumers.” The Examiner will use “product information” when referring to the claimed consumer information in the discussions below.

Claims 30, 55, 57, and 58: Reisman discloses a method for providing consumers with product information, comprising:

- a. receiving a selection of a product available for purchase from the consumer (original/containing information product)(column 11, lines 5-16 and column 26, lines 13-27);

- b. providing to the consumer one or more subscription offers organized by subject areas pertaining to the product and including a price of the product (Reisman allows the consumer to subscribe to receive periodic updates or enhancements to the purchased containing information product, e.g. an electronic magazine or software application)(column 11, lines 26-38; column 20, lines 10-18; column 21, lines 20-25; column 25, lines 59-62; and column 26, lines 13-27);

- c. receiving a selection from the consumer of one or more of the subscription offers wherein at least one of the subscription offers include a price or price range the consumer will pay for the product (column 11, lines 26-38; column 18, lines 30-32; column 20, lines 10-18; column 21, lines 20-25); (The Examiner notes that when a consumer accepts an offer that includes a price, then the price inherently must be one that the consumer is willing to pay.) and

d. formatting deliverables to be sent to the consumer according to the subscription including the product information upon meeting the conditions of the subscription (column 11, lines 39-54 and column 18, lines 30-32),

Reisman further discloses the consumer designating delivery parameters for the subscription to include how the information is to be delivered and what portion of the information is to be delivered (column 14, lines 35-63 and column 21, lines 59-65).

While Reisman does not explicitly disclose the condition of the subscription include an opportunity to purchase the product at or below said price (e.g. at a discount or rebate price), Solomon discloses a similar method for providing consumers with product information (column 3, lines 59-63, column 8, lines 17-30; and column 11, lines 40-45) in which the consumer, upon selecting and completing a subscribing action such as completing a rebate form or *purchasing a supplement product* (Figure 9; column 8, lines 36-42; column 10, lines 56-64; and column 12, lines 3-16), receives a rebate on the original product and that the rebate may be disburses to the consumer in several ways to include a "product discount" or debit transaction to the consumer's credit card, i.e. effectively reducing the cost of the original product (column 5, lines 40-47 and column 10, lines 21-25)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Reisman to give the consumer a discount (rebate) on the cost of the original product upon selecting one the subscription offers. One would have been motivated to give the consumer a reduced price on the original product in order to entice the consumer to accept one or more of the subscriptions,

Art Unit: 3688

especially when Reisman discloses that the subscription offer could be for informational product pertaining to the original product, e.g. updates, current news reports, product enhancements, etc.

Claims 31 and 56: Reisman and Solomon disclose a method as in Claims 30 and 55 above, and Reisman further discloses that the product is a service (e.g. electronic newspaper or television service)(column 11, lines 5-16 and column 25, lines 42-65).

Claim 32: Reisman and Solomon disclose a method as in Claim 30 above, and Reisman further discloses receiving search constraints including company, brand, product, or service (column 11, lines 7-29).

Claim 33: Reisman and Solomon disclose a method as in Claim 30 above, and Reisman further discloses receiving search criteria and returning the search results (column 12, lines 7-15).

Claim 34: Reisman and Solomon disclose a method as in Claim 30 above, and Reisman further discloses receiving selection of topic and subtopic information (column 12, lines 7-29).

Art Unit: 3688

Claim 35: Reisman and Solomon disclose a method as in Claim 30 above, and Reisman further discloses that the product could be stored on a CD-ROM that is delivered to the consumer who then telephones in the product code to start the interactive method to retrieve the subscription offers (column 22, line 66 – column 23, line 18). While Reisman does not explicitly disclose that the code is a barcode read by the consumer's device, Solomon discloses using such barcodes to identify the product (column 8, lines 17-42). The Examiner also notes that many types of consumer products have had the capability of scanning barcodes, such as cell phones, barcode readers attached to the consumer's desktop computer, handheld barcode scanners, etc. Such barcode scanners have been used in the Patent Office by examiners to scan the barcodes of applications (e.g. information products) since the mid1990's when the instant examiner arrived in the Office. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Reisman to identify the product with a barcode and to require the consumer to enter the barcode when identifying the product for which the rebate pertains. One would have been motivated to use a barcode to identify the product in order to reduce data entry errors and in view of the ubiquitous use of barcodes on products for just that reason.

Claim 36: Reisman and Solomon disclose a method as in Claim 35 above, and Reisman further discloses that the consumer device is a personal digital assistant or mobile phone (column 10, lines 44-52; column 14, lines 6-67; column 28, lines 60-67; and column 29, lines 11-20).

Claim 37: Reisman and Solomon disclose a method as in Claim 30 above, and Reisman further discloses the product information includes dynamic information, e.g. news articles (column 25, lines 59-65).

Claim 38: Reisman and Solomon disclose a method as in Claim 30 above, and Reisman further discloses the consumer specifies the subject area, such as frequency of delivery, a delivery schedule, a delivery when the product information reaches a threshold, a delivery date range, and action by a supplier, or an action by the consumer (column 11, lines 44-49 and column 13, lines 64-66).

Claim 39: Reisman and Solomon disclose a method as in Claim 30 above, and Reisman discloses the subject area comprises: discounts, comparison, new releases, general information, catalogs, or special offers (column 11, lines 26-38).

Claim 40: Reisman and Solomon disclose a method as in Claim 30 above, and Reisman further discloses the subject area comprise request services (column 11, lines 26-38).



Art Unit: 3688

Claim 41: Reisman and Solomon disclose a method as in Claim 30 above, and Reisman further discloses the deliverables include an email, a mail message, a page, a telephone call, and telephone message, a mobile phone call, a mobile phone message, or a message to the consumer computer device (column 14, lines 35-40).

Claim 42: Reisman and Solomon disclose a method as in Claim 30 above, and Reisman further discloses the deliverables allow the consumer to purchase the product (column 21, lines 39-53 and column 26, lines 22-27).

Claims 43 and 44: Reisman and Solomon disclose a method as in Claim 30 above, and a method as in Claim 30 above, and Reisman further discloses the deliverables allow the consumer to access additional online information (e.g. updated news stories) from a vendor of the product (newspaper)(column 14, lines 35-40).

Claim 45: Reisman and Solomon disclose a method as in Claim 1 above, and Reisman further discloses the deliverables allow the consumer to select one or more subject areas (column 21, lines 20-25).

Claims 59 and 60: Reisman and Solomon disclose a method as in Claim 30 above, and Reisman further discloses gathering the product information from the provider of the product (column 19, line 63 - column 20, line 1). While it is not explicitly disclosed that the provider will be asked for consent to provide the product information to the

consumer, it would have been obvious for Reisman to do so. Many products have proprietary information and/or trade secrets that the provider would not desire to release to everybody, but that the provider would agree to release to certain subscribers, purchasers, and others with a need-to-know. Thus, one would have been motivated to request approval from the product provider prior to releasing the product information to the consumer in order to provide assurance to the product provider that only authorized information was being released only to authorized consumers.

### ***Response to Arguments***

4. Applicant's arguments filed October 21, 2009 have been fully considered but they are not persuasive.

a. The Applicant argues that the subscription delivery in Reisman "is simply a way to install Reisman's software to fetch information" (page 7). The Examiner disagrees. As discussed above, Reisman teaches the consumer purchasing a product, such as a software application or electronic newspaper, magazine, catalog, or other publication, and then subscribing to have updates or enhancements periodically downloaded and presented to the consumer. These downloads may be automatically stored and associated with or integrated into the purchased product, or they may require approval (or purchase) by the consumer. For example, if the purchased product was a software application, such as an online game, the consumer would subscribe to be automatically notified of any subsequent update to the product, such as an update to correct errors (usually free) or a new expansion to the game (usually required to be

Art Unit: 3688

purchased). Upon receipt of the update, the consumer may need to approve the installation (or purchase), or the installation may be automatic, both of which are discussed by Reisman. The Examiner notes that he has participated in such automatic notification of updates and new expansions for on-line games (which required the purchase of a CD-ROM containing the initial game software), such as Federation™, Everquest™, and World of Warcraft™, since the mid-1990s. In each instance, not only was the update/expansion installed (after approval or purchase), but an information message was presented providing an explanation of what was being corrected, what the new expansion contained, additional updates/enhancements/products that were available for purchase, etc. Thus, Reisman's disclosure of the consumer approving the automatic notification and/or download of subsequent material pertaining to the purchased product is considered to be a "subscription" to such subsequent product information.

b. The Applicant argues that Solomon "is simply a rebate processing disclosure" (page 7). The Examiner notes that Solomon was only used in the rejection to show that it was known to offer products at a reduced or discounted price (such as rebating part of the purchase price) and that the use of barcodes to identify products was also known at the time of the invention.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES W. MYHRE whose telephone number is (571)272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Weinhardt can be reached on (571) 272-6633. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3688

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JWM  
December 9, 2009

/James W Myhre/  
Primary Examiner, Art Unit 3688